

Appl. No. 09/935,895
Final Amendment and/or Response
Reply to Office action of 30 December 2003

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REMARKS / DISCUSSION OF ISSUES

Claims 6-11 are pending in the application.

Applicant(s) thank(s) the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority document(s).

The Office action rejects claims 6-8 and 10 under 35 USC § 103(a) over applicants' FIG. 3 in view of Saito et al. (JP 3-241801). Applicants respectfully traverse this rejection. As explained below, claims 6 and 10, and therefore also claims 8, 9, and 11 that depend directly or indirectly from independent claim 6 or 10, are patentable over any permissible combination of the cited reference(s).

Claim 6-11 are patentable at least because neither FIG. 3 nor Saito et al. teach or suggest the homogeneously distributed synthetic resin having a concave surface as recited in independent claims 6 and 10. The Office action once again asserts that "Saito et al. inherently discloses a concave/convex surface at the spacer." However, as applicants pointed out in the previous Response (paper No. 28) to the previous non-final rejection (paper No. 22-23), the Office action provides no evidence to support this assertion but conjecture. Applicants maintain this position. To establish inherency, an examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. **MPEP 2112**. However, the final Office action continues to fail to present any objective evidence or cogent technical reasoning that would support an assertion of inherency.

In response to applicants' legitimate request that the Examiner provide such evidence, the final Office action offers no evidence, but only repeats that the magnetic filling of Saito et al. "would inherently [form] a concave/convex surface." Initially, applicants note that claims 6 and 10 recite a concave surface, not a concave/convex surface. Accordingly, the Examiner has not even asserted that the claimed structure would be inherent.

Further, **MPEP § 2144.03** requires that when the examiner takes official notice of facts outside of the record and applicants traverse such an assertion, as was done

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in the prior Response, the examiner should cite a reference in support of his or her position, or, if a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. The Examiner has done neither, and therefore **the final Rejection is incomplete and is in violation of MPEP § 2144.03 and 37 C.F.R. §1.104(d)(2).**

"if applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence." **MPEP 2144.03 C.** It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697; Ahlert, 424 F.2d at 1092, 165 USPQ 421. **MPEP 2144.03 E.** Applicants therefore respectfully request that the Examiner be directed to cite the appropriate prior art to support his position or to file the personal affidavit required by 37 C.F.R. §1.104(d)(2), or if not, to allow claims 6 and 10 as well as the claims dependent thereon, i.e. claims 7-9 and 11. Further, any such support must be given in a non-final Office action, since the rules require that "applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." **MPEP 2144.03 B.**

Further, if the examiner is relying on a **scientific theory** for his assertion that his statement that the magnetic filling of Saito et al. "would inherently [form] a concave/convex surface" then he must provide evidentiary support for the existence and meaning of that theory. In re Grose, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979). **MPEP 2144.02.**

Additionally, applicants renew their assertion that the examiner has pointed to no motive or teaching that would cause one of ordinary skill in the art to combine the spacer filling material of Saito et al. with the ring-shaped core of FIG. 3, except for the bald statement that it would have been obvious to combine the spacer filling

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material of Saito et al. with admitted priority "for the purpose of controlling the magnetic field of the device." The factual inquiry whether to combine references must be thorough and searching and must be based on objective evidence of record. In re Lee, 61 USPQ 2d 1430, 1433 (Fed Cir 2002). A factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. Id. at 1434. However, the Examiner has provided no rationale as to why such a motive would have prompted one of ordinary skill in the art (other than applicants' own disclosure) to make such a combination. Thus the Examiner has not shown motivation for combination under 35 USC § 103(a). Accordingly, the rejection of claims 6-8 and 10 under 35 USC § 103(a) should be withdrawn for this reason as well.

The Office action rejects claims 9 and 11 under 35 USC § 103(a) as above and further in view of U.S. Pat. No. 6,246,172 to Bizen et al. Applicants respectfully continue to traverse this rejection as well. Claims 9 and 11 are patentable at least because they depend from independent claim 6 which is patentable as explained above. Additionally, the two references cannot be combined because there is no motivation in either reference to use the resin of Saito et al. in a two-gap core such as in Bizen et al., for reasons that are readily apparent one of ordinary skill in the art. Accordingly, the rejection of claims 9 and 11 under 35 USC § 103(a) should be withdrawn for this reason as well.

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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